

**THIS OPINION IS NOT
CITABLE
AS PRECEDENT OF
THE TTAB**

**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451**

Goodman

Mailed: October 19, 2004

Opposition No. **91125436**

GRUPO INDUSTRIAL TLAJOMULCO
S.A. DE C.V. f/k/a/ TEQUILA
CAZADORES, S.A. DE C.V. and
BACARDI COMPANY LIMITED

v.

TEQUILA CENTINELA, S.A. DE
C.V.

**Before Simms, Hairston, and Bucher, Administrative Trademark
Judges.**

By the Board:

On February 24, 2004, the Board granted opposers' motion for summary judgment on the ground of fraud, but found a genuine issue of material fact with regard to opposer Bacardi Company Limited's (hereinafter "Bacardi")¹ standing.² The Board allowed Bacardi time to file

¹ In that order, the Board granted Bacardi's motion to substitute for opposer Tequila Cazadores S.A. de C.V. (hereinafter "Tequila Cazadores") to the extent that it joined Bacardi as a party opposer.

² The Board noted that there was a genuine issue as to the veracity of the documents submitted to allege a transfer of interest from Tequila Cazadores to Bacardi. Additionally, the Board noted that Bacardi had not submitted a status and title copy of the pleaded registration, Reg. No. 1863882 for the mark CAZADORES for "alcoholic beverages, namely tequila." In a June 18, 2004 supplemental filing, Bacardi provided documentation of its request for a certified copy of the registration from the Office.

additional documentation to show that there was no genuine issue of material fact with respect to standing.

On March 28, 2004, Bacardi filed its additional documentation. In its response, Bacardi states that it acquired the CAZADORES trademarks from Tequila Cazadores through "a series of agreements executed between the parties and their affiliates"; that due to the "sensitive--and highly confidential--nature of such documents, Bacardi also entered into confirmatory assignments confirming the chain of title"; that the "complex" transaction involved foreign companies; that "the relevant documents are not in English"; and that "prior to the confirmatory assignment documentation, Tequila Cazadores underwent a name change."

In response, applicant points out that the documents Bacardi provided indicate that Tequila Cazadores changed its name to Grupo Industrial Tlajomulco S.A. de C.V. (hereinafter "Grupo Industrial") on September 3, 2002; that the name change was after Grupo Industrial assigned the Cazadores marks, on May 31, 2002, to Domino Recreativo S.A. (hereinafter "Domino Recreativo"); that therefore, Grupo Industrial "purported to assign to Domino Recreativo the rights to marks that it did not own"; that the assignment from Domino Recreativo to Bacardi is "unusual" because the assignment documents were not signed until a year after the alleged assignment took place; and that one of the documents

submitted to support the assignment from Domino Recreativo to Bacardi is signed by "outside counsel for opposer Bacardi (with no proof that outside counsel is or was a Bacardi officer)." Applicant asserts that summary judgment on standing at this time is inappropriate because Bacardi has not "provid[ed] properly documented proof that it acquired by assignment the trademark rights of the original Opposer Tequila Cazadores upon which this Opposition is based", and there remain genuine issues of material fact with respect to the "propriety of the mesne assignments" which resulted in Bacardi's "alleged acquisition of the trademark rights upon which this Opposition is based."

With regard to the remaining issue of standing with respect to opposers' motion for summary judgment, the moving party has the burden of establishing the absence of any genuine issues of material fact and that it is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56(c). All reasonable inferences must be viewed in the light most favorable to the non-moving party. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

Having carefully considered the arguments and evidence submitted by the parties, we find that there is no genuine issue of material fact with regard to opposers' standing.

The documents submitted, as recorded in the Office's Assignment Branch at Reel 2719, Frames 0790 and 0829 and Reel 2857, Frame 0931 establish that Tequila Cazadores had a change of name to Grupo Industrial; that Grupo Industrial f/k/a Tequila Cazadores, assigned its pleaded mark, Reg. No. 1863882 to Domino Recreativo on May 31, 2002; and that also on that day Domino Recreativo assigned Reg. No. 1863882 to Bacardi.

Through the chain of title, opposers have established that they have a real interest in this proceeding and, therefore, they have established their standing to pursue this opposition. See *Richie v. Simpson* 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999). This is so even though there may be some question about when Tequila Cazadores' change of name to Grupo Industrial actually occurred. Grupo Industrial f/k/a Tequila Cazadores was the owner³ and assignor of Reg. No. 1863882 and Bacardi is presumed to be the final purported assignee as shown by the chain of title. Moreover, Grupo Industrial f/k/a Tequila Cazadores, is still a party, and as owner and assignor of the CAZADORES mark, had some interest in filing this proceeding. Likewise, joined opposer Bacardi is no mere intermeddler as evidenced by the execution of the purchase agreement between itself

³ The mark was assigned to Tequila Cazadores on November 27, 1996 and recorded in the Office's Assignment Branch on December 12, 1996 at Reel 1537, Frame 0911.

and Domino Recreativo (dated May 30, 2002) which states that Bacardi would obtain "any and all rights currently or formerly held by any affiliate of the seller in and to the Cazadores trademark in the United States, including any and all rights based on use and any and all rights based on U.S. Registration No. 1863882." Thus, even if there were a problem with the timing of the purported assignment,⁴ Bacardi has clearly demonstrated, by the terms of its purchase agreement with Domino Reactivo its right to use Reg. No. 1863822 and CAZADORES marks in the United States and its commercial interest in the registrability of the opposed mark.⁵

Accordingly, there is no genuine issue with regard to opposers' standing. Summary judgment already having been granted on the ground of fraud by the Board order dated

⁴ The Board notes that Bacardi filed with the Office's Assignment Branch on September 7, 2004 and October 4, 2004, corrective assignments "in the nature of nunc pro tunc conveyances" with respect to the assignment between Grupo Industrial and Domino Reactivo and the assignment between Domino Reactivo and Bacardi, recorded at Reel 2933 Frame 0538 and Reel 2951, Frame 0202, respectively.

⁵ A plaintiff may have standing and may succeed in a case brought under Section 2(d) of the Trademark Act even if it does not claim ownership of the assertedly similar mark, or the right to control its use. See *J.L. Prescott Co. v. Blue Cross Laboratories (Inc.)*, 216 USPQ 1127 (TTAB 1982) (opposer that had assigned mark and obtained exclusive license from assignee held to have standing); See also, *Universal Oil Products Co., v. Rexall Drug and Chemical Co.*, 463 F.2d 1122, 174 USPQ 458 (CCPA 1972); *BRT Holdings Inc. v. Homeway Inc.*, 4 USPQ2d 1952 (TTAB 1987); *Chemical New York Corp. v. Conmar Froms Systems, Inc.*, 1 USPQ2d 1139 (TTAB 1986); and *Yasutomo & Co. V. Commercial Ball Pen Co., Inc.*, 184 USPQ 60 (TTAB 1974); *William & Scott Co. v. Earl's Restaurants Ltd.*, 30 USPQ2d 1870, 1873 n.2 (TTAB 1994).

February 24, 2004, judgment is hereby entered against applicant on the ground of fraud, the opposition is sustained, and registration to applicant is refused.